

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TAKEHIKO TOJO, ET AL. : EXAMINER: DOAN, R.K.
SERIAL NO: 10/562,977 :
FILED: DECEMBER 29, 2005 : GROUP ART UNIT: 3732
FOR: HAIR HOLDER :
:

RESPONSE TO OBJECTION FOR LACK OF UNITY OF INVENTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Objection for Lack of Unity of Invention dated September 25, 2009, Applicant elects, with traverse, **Group I**, listed in the Objection as readable on Claims 1-5, 7-16, and 18-21.

Applicant further elects, with traverse, the **Species (III)** indicated in the Objection as readable on Claim 9. Applicants list Claims 1, 6-9, and 17 as readable thereon.

The Objection indicates that Claims 1, 6, and 17 are generic.

Applicant traverses the Objection as follows. MPEP § 1850 that notes that:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category (for example, "Apparatus for carrying out the process of Claim 1 ...," or "Process for the manufacture of the product of Claim 1 ..."). Similarly, a claim to one

part referring to another cooperating part, for example, "plug for cooperation with the socket of Claim 1 ...") is not a dependent claim.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner such that it avoids the prior art, while claim 2 is for a "turbine rotor blade as claimed in claim 1" and produced from alloy Z. Then no objection under PCT Rule 13 arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent possibly later patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades. As another example, suppose that the main claim defines a process avoiding the prior art for the preparation of a product A starting from a product B and the second claim reads: "Process according to claim 1 characterized by producing B by a reaction using the product C." In this case, too, no objection arises under PCT Rule 13, whether or not the process for preparation of B from C is novel and inventive, since claim 2 contains all the features of claim 1. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art, provided the genus claim is directed only to alternatives of a similar nature and the species falls entirely within the genus. To determine if a genus claim is directed only to alternatives "of a similar nature," see subsection III.B. below. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(Emphasis added). To show lack of unity of invention, the PTO must show that this subcombination "A" lacks novelty before a requirement asserting lack of unity of invention can be made.

In the present case, dependent Claims 2-5 and 7-16 depend from or otherwise require all the features of independent Claim 1. The outstanding Office Action has not established that the features of Claim 1 are known as required by MPEP § 1850 above. Accordingly, Applicant respectfully submits that all the dependent claims should be examined along with independent Claim 1.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Chinn, Ph.D.
Attorney of Record
Registration No. 34,305

Lee L. Stepina
Registration No. 56,837

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)